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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,796	10/25/1999	MUMTAZ SHAH		7704

7590 03/26/2002

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EXAMINER

GOODMAN, CHARLES

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/403,796

Applicant(s)

SHAH, MUMTAZ

Examiner

Charles Goodman

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. The Amendment filed on January 8, 2002 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Chuang.  
Chuang discloses a plastic film cutter comprising all the elements claimed including, *inter alia*, a unit (e.g. 308 in Figs. 3A-B); a lower part 323, 324, 325, 326 defining a sheet support surface (e.g. near 324 in Fig. 3C); an upper part 308; a gap (not designated by reference but see Figs. 3C-3D); a cutting blade 319, 320; pressure means 309-312; and a holder 329. See whole patent.

Regarding the “freely movable” functional recitation in claim 20, no structure has been set forth that is directly related to this function. Therefore, it has not been given significant patentable weight. Moreover, this recitation relates to the intended use of the device since it is clear from the specification that this functional recitation or capability is wholly dependent upon how the user intends to use the same. Therefore, it will not be given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). On the other hand, Chuang’s unit is freely movable when used without the supporting board since there is nothing in the claims that precludes this reading of Chuang.

Art Unit: 3724

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang in view of Shah (GB 2,223,976).

Chuang discloses the invention substantially as claimed except for matching sinusoidal surfaces on the upper and lower parts. However, Shah teaches a cutting device comprising upper and lower parts 3, 2 having matching sinusoidal surfaces (Fig. 6) which enhances tensioning of sheet material 1 to be cut. See Fig. 6, p. 4, ll. 6-15. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Chuang with the sinusoidal matching surfaces as taught by Shah in order to facilitate enhanced tensioning of the sheet material to be cut.

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang in view of Li.

Chuang discloses the invention substantially as claimed except for a window. However, Li teaches a window (the cut out portion above 24 in Fig. 1) which inherently serves as a means to visually observe the cutting action or the line of cut. See Fig. 1. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Chuang with the window as taught by Li in order to facilitate proper alignment and cutting of the sheet material.

7. Claims 20-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Campbell Jr..

Art Unit: 3724

Li discloses the invention substantially as claimed including upper and lower parts 1, 2, a gap therebetween (not designated by reference but see Fig. 1), a cutting blade 23, and a blade holder 22. See whole patent. However, Li lacks a pressure means. In that regard, Campbell Jr. teaches a cutter having a pressure means or roller 17 disposed immediately in front of a cutting blade 14 for the purpose of placing the sheet material to be cut under tension. See Figs. 2-5, c. 3, ll. 5-37. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Li with the pressure means as taught by Campbell Jr. in order to facilitate enhanced tensioning of the sheet material during cutting.

Regarding the "freely movable" functional recitation in claim 20, no structure has been set forth that is directly related to this function. Therefore, it has not been given significant patentable weight. Moreover, this recitation relates to the intended use of the device since it is clear from the specification that this functional recitation or capability is wholly dependent upon how the user intends to use the same. Therefore, it will not be given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). On the other hand, Li's unit is freely movable in a plurality of directions since there is nothing in Li's teachings that is contrary to this reading of Li.

8. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Campbell Jr. as applied to claims 20-22 and 24 above, and further in view of Shah (GB 2,223,976).

Art Unit: 3724

The modified device of Li discloses the invention substantially as claimed including substantially matching faces that facilitate sinusoidal shaping of the material to be cut and thereby provide tension. See Figs. 1-6. However, the faces themselves are not sinusoidal. In that regard, Shah teaches that sinusoidal matching faces is a well known face shape in the art. More specifically, Shah teaches a cutting device comprising upper and lower parts 3, 2 having matching sinusoidal faces (Fig. 6) which enhances tensioning of sheet material 1 to be cut. See Fig. 6, p. 4, ll. 6-15. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Li with the sinusoidal matching faces as taught by Shah in order to facilitate tensioning of the sheet material to be cut or to substitute the sinusoidal faces of Shah for the non-sinusoidal faces of Li, modified, since either shapes are deemed to be equivalent means of tensioning and to substitute one for the other would have been an obvious matter of design choice, and since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art, especially since such a change does not render unexpected or unobvious results. *In re Rose*, 105 USPQ 237 (CCPA 1955).

### ***Response to Arguments***

9. Applicant's arguments filed June 27, 2001 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that Chuang does not anticipate the claimed invention because Chuang lacks a unit "capable of freely moving in both linear

Art Unit: 3724

and non-linear paths”,<sup>1</sup> this argument is traversed. First, as noted in the rejection *supra*, the unit disclosed in Chuang is fully capable of movement in the paths as claimed when the unit is used alone. Furthermore, what structure has Applicant set forth in the claim, besides the functional recitation, that specifically limits the invention to cutting both linear and non-linear paths? What specific recited structure allows the claimed “unit” to cut non-linearly that is different from the prior art? There is nothing in the claim that specifically allows the claimed “unit” to cut in a non-linear path. Moreover, this recitation in the claim is related to the intended use of the device, and as such, it has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The path of cut is defined by the user whether the user uses an alignment means that restricts the direction of the path or not. Thus, if a user wishes to cut a non-linear line, then the user merely pushes the cutter in the desired path. In sum, there is no patentable distinction between the structures of the prior art and that claimed. The same points applies to all similar arguments against the references. Second, it is irrelevant whether Chuang actually teaches away from Applicant’s concept since this has no bearing under 35 USC § 102.

In response to Applicant’s basic argument that Li in view of Campbell Jr. does not render the claimed invention obvious because Li’s invention is used to cut

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<sup>1</sup> See Amendment D, Paper No. 13, p. 7, l. 15 - p. 8, l. 20.

Art Unit: 3724

“wrappage” and cuts in a different manner than Applicant’s invention,<sup>2</sup> this argument lacks merit. Because these arguments are substantially the same as set forth in the last amendment,<sup>3</sup> the Examiner’s responses thereto in the last Office Action equally applies.<sup>4</sup>

In response to Applicant’s basic argument that Campbell Jr. is not analogous art,<sup>5</sup> this argument lacks merit. Applicant argues the same points raised in the last amendment<sup>6</sup> and the Examiner’s response thereto equally applies.<sup>7</sup>

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703)

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<sup>2</sup> *Id.*, p. 9, l. 1 - p. 11, l. 10.

<sup>3</sup> Compare footnote 2 and Amendment C, p. 6, l. 10 - p. 10, l. 22.

<sup>4</sup> See last Office Action, Paper No. 11, p. 6, l. 14 - p. 7, l. 9.

<sup>5</sup> Amendment D, p. 11, l. 11 - p. 14, l. 4.

<sup>6</sup> Compare footnote 5 and Amendment C, p. 8, l. 19 - p. 10, l. 18.




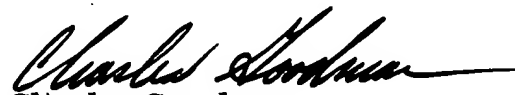
Art Unit: 3724

308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (703) 308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

cg   
March 25, 2002

  
Charles Goodman  
Patent Examiner  
AU 3724

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<sup>7</sup> See last Office Action, Paper No. 11, p. 7, l. 10 - p. 10, l. 4.